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PATENT

Attorney Docket No.: 17342-000500US

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On June 7, 1999

TOWNSEND and TOWNSEND and CREW LLP

By: Janet Byrne

OIPE JC57 JUN 10 1999 PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Barney D. Visser

Application No.: 08/851,040

Filed: May 5, 1997

For: SYSTEMS AND METHODS FOR FACILITATING THE PRESENTATION OF INVENTORY ITEMS

Examiner: T. Kang

Art Unit: 3635

RESPONSE

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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a Response to the Office Action mailed March 5, 1999. In the Office Action, claims 1-4, 6-16 and 18-36 were examined. In this response, no claims have been amended. Reconsideration of the claims in light of the following remarks is respectfully requested.

In the Office Action, all of the examined claims were rejected on three different grounds. First, under 35 USC 103(a) as being unpatentable over the Searcy patent. Second, all of the claims were rejected in view of Judicial Notice ("the first Judicial Notice") relating to department stores such as Macy's, Nordstrom, Bloomingdale's, etc. Third, all of the claims were rejected under Judicial Notice ("the second Judicial Notice") relating to malls such as Potomac Mills, Tysons Corner and Pentagon City Mall. All of these rejections are respectfully traversed.

The Searcy Patent

In rejecting the claims in view of the Searcy patent, the Examiner recognized that Searcy fails to describe that each store has at least one separate outside entrance which leads directly to a parking facility. To teach such a limitation, the Examiner stated as follows, "the examiner takes judicial notice that this is common practice in most shopping plazas and would therefore been obvious to one having ordinary skill in the art." Applicant respectfully disagrees.

The Examiner's rejection is tantamount to reciting that doors are known in the art so that it would have been obvious to use a door for each store as claimed. However, no teaching or suggestion is found in the Searcy patent, or in knowledge generally available in the art, to provide at least three separate stores, with each having its own separate doorway which leads to a parking facility, and with each of the separate stores being interconnected with common doorways and aisles as claimed, for example, in claim 1. By taking Judicial Notice in this manner, the Examiner is simply stating an opinion that it would have been obvious to modify Searcy in the manner claimed in claim 1 of the present application. This is clearly hindsight construction of the prior art, which hindsight reconstruction is clearly impermissible.

Even assuming, arguendo, that shopping plazas exist having stores with doors as recited in the Office Action, such a reference provides no teaching or suggestion to provide stores which are interconnected from within and have separate outside doors as claimed in claim 1. Indeed, because room 66 of Searcy is a storeroom for goods which are not displayed, there is no need to provide a customer entrance from a parking facility. See column 4, lines 66-68. Hence, the Office Action clearly fails to present a *prima facie* case of obviousness. It is therefore respectfully requested that the rejection of independent claim 1 and dependent claims 2-4 and 6-10 be withdrawn. Independent claims 16 and 21, and dependent claims 18-20 and 22-24 include similar limitations. Hence, it is respectfully requested that the §103 rejection of these claims in view of Searcy be withdrawn for at least the reasons previously cited.

Independent claims 11, 25 and 31 each include the limitation that the separate stores are separated by walls which each include a pair of doorways. An aisle is provided which circuits through each of the doorways. As set forth in the Examiner's Interview

Summary Report, the Examiner recognized that the Searcy patent fails to teach or suggest such limitations. For example, as shown in Fig. 1 of Searcy, rooms 64 and 66 are separated by only a single doorway 84 and these rooms do not include a pair of doorways so that an aisle may circuit through each of the doorways for each of the stores as claimed. Hence, it is respectfully requested that the §103 rejection of independent claims 11, 25 and 31, along with their respective dependent claims, be withdrawn.

The First Judicial Notice Rejection

In the Office Action, the Examiner cited that, "the examiner takes Judicial Notice that in most department stores such as Macy's, Nordstrom, Bloomingdale's, etc., there are separate sections/departments (with orthogonal walls and distinct entrances which directly to a parking facility) reserved for special merchandises such as designer's, furs, evening wears, etc. that could be considered as "separate stores" which are managed independently from one another." Applicant respectfully disagrees that the first Judicial Notice presents a *prima facie* case of obviousness. For example, as presently pending, claim 1 includes the limitation of at least three separate stores which each have a separate outside entrance leading directly to a parking facility. Further, an elongate wall separates each store, with each wall having a doorway, and with the doorways being aligned with each other. Further, an aisle passes through each doorway such that the customer may visualize at least some of the interior of each store while standing in the aisle and looking down the aisle.

As understood by the applicant, the separate sections/departments of a department store, such as Macy's, are not separate stores. Rather, these are departments within the same store. Hence, the claims are distinguishable for at least this reason.

Further, Counsel for the Applicant has visited several department stores across the country and has been unable to identify a department store having all of the limitations of claim 1. Indeed, the Nordstrom stores with which Counsel for the Applicant is familiar have an open interior and do not have separate sections/departments with walls having doorways.

According to MPEP 2144.03, the Examiner may only take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. Clearly, the fist Judicial Notice rejection taken by the Examiner

does not meet this standard. Hence, according to MPEP 2144.03, Applicant respectfully requests that the Examiner state the facts as specifically as possible and place these facts in an affidavit. Absent such an affidavit from the Examiner, this Judicial Notice rejection is improper and it is respectfully requested that the first Judicial Notice rejection be withdrawn.

The Second Judicial Notice Rejection

In the second Judicial Notice, the Examiner recited that, "in many malls such as Potomac Mills, Tysons Corner, Pentagon City Mall, all located in Northern Virginia, there are separate stores (with orthogonal walls and multiple distinct outside entrances) each specializing in one type of merchandise, such as, furniture, clothing, toys, etc., that is managed by their own salestaff. Since most mall lay-outs include distinct wings, many stores would have both inside and outside entrances and the doors are usually aligned because most stores run along a straight elongated corridor." Applicant respectfully disagrees that such malls present a *prima facie* case of obviousness.

As previously described, independent claim 1 claims at least three separate stores which include an outside entrance to a parking facility. Further, an elongate wall separates each store, and each wall includes a doorway, with the doorways being aligned with each other. Counsel for the Applicant previously requested information regarding the types of malls recited in the Second Judicial notice rejection. Accordingly, the Examiner faxed to Counsel for the Applicant a floor plan of the Tysons Corner mall and the Potomac Mills mall. As set forth in Applicant's previous response, none of these malls describe at least three stores which each have outside entrances leading directly to a parking facility and interior walls having doorways which are aligned so that customers may pass through each of the stores from within the stores. Rather, with the malls recited in the second Judicial Notice, the customers are required to exit a store, pass through an aisle in the center of the mall, and then enter another store. Hence, the references cited in the second Judicial Notice clearly do not include all of the limitations of the claims. Hence, it is respectfully requested that the rejection under the second Judicial Notice be withdrawn and the application be passed to allowance.

Final Comments

In the Office Action, the Examiner has provided a section entitled "Response to Arguments". In one section, the Examiner refers to the stores "The Limited" and "The Limited Too". The Examiner recited that each of these stores have outside entrances. However, this is clearly not illustrated in the floor plan provided by the Examiner. Hence, Applicant respectfully disagrees with the Examiner's interpretation of this reference.

In another section of the Examiner's comments, the Examiner indicates that Counsel's arguments with respect to claim 16 are not persuasive since, "most shopping plazas contain the recited elements and are therefore not patentable." Again, the Examiner is relying on prior art which may not even exist. At a minimum, the Examiner should provide a reference so that an accurate record can be produced and giving the Applicant a fair opportunity to respond.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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